

## REMARKS

Claims 1-20 remain in this application.

### *Claim Rejections - 35 USC 112*

Claims 1-12 were rejected as being indefinite due to the use of the term “useful in conducting the business transaction,” which allegedly lacks an antecedent basis and uses an undefined term “useful.”

Applicant respectfully traverses this rejection. The term “the business transaction” has an antecedent basis in the claim preamble of amended claim 1: “A method for the creation of an electronic container to conduct *a business transaction* comprising...”

Furthermore, Applicant respectfully submits that claim language defines “the patentable subject matter with a reasonable degree of particularity and distinctness” as required by MPEP 2173.02. As discussed in the specification at page 2:

In environments where electronic files are *used*, there are still difficulties encountered by *businesses* trying to implement such files to *transact business*. As in many cases, a collection of different types of electronic files will comprise the transaction. One of the deficiencies of the presently known systems is that there is a lack of a single “container” that can hold various objects to better allow companies to interact or act as a general purpose electronic information delivery vehicle. Therefore, what is needed is a process to allow a disparate collection of different objects, be it electronic, or paper converted into electronic format be provided to a business or even and end user in a fashion the promotes ease of use an automation. (Emphasis added).

In view of this disclosure, Applicant submits that one of ordinary skill in the art would understand what makes an object useful within the limitations of the claims.

For these reasons, Applicant submits the claims meet the requirements of 35 USC 112,

¶1.

### *Claim Rejections - 35 USC 102*

Claims 1-16 and 18-20 have been rejected by the examiner under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,108,656 issued to Durst et al. To anticipate a claim, the

reference must teach every element of the claim:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

The *invention* disclosed in Durst et al. is that of a so-called intelligent document in which machine-readable codes on a printed document are used to encode machine-readable pointers to the locations of electronic information. *As a whole*, the invention of Durst et al. is to encoding machine accessible information on a printed document: "the present invention is a method and system for a computer, such as a client computer in a networked computer system, to retrieve a computer file in which a symbol data string comprising a file location pointer is encoded into a machine readable symbol such as a two-dimensional bar code symbol, and the machine readable symbol is rendered within a data carrier (e.g. printed on an intelligent document). A computer input device such as a two-dimensional bar code scanner is coupled to the client computer and transposes an input data string from the machine readable symbol. The computer parses the input data string to determine the file location pointer, and the file location pointer is then utilized pointer to request the computer file designated thereby."

The presently claimed invention is to "an electronic container" that seeks to eliminate paper documents. As an electronic container, the graphical code is also electronic, unlike Durst et al., which fails to disclose any electronic container.

Claims 1, 7, and 13 include limitations to an electronic package that are not disclosed or fairly suggested in Durst et al. For this reason, Durst et al. cannot anticipate claims 1, 7, and 13 or the claims 2-6, 8-12 and 14-20 that depend therefrom. Applicant submits that claims 1-20 are allowable over the cited prior art.

#### *Claim Rejections - 35 USC 103*

Claim 17 of the present invention has been rejected under 35 U.S.C. §103(a) as being

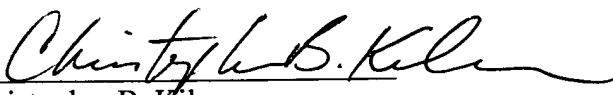
unpatentable over Durst et al. as applied to claim 16 and further in view of U.S. Patent 6,215,992 issued to Howell et al.

As discussed above with respect to anticipation, Durst et al. fails to disclose the claimed invention and the "Universal dictation input apparatus and method" of Howell et al. fails to address any of the deficiencies of Durst et al. As such, claim 17 is allowable for the same reasons as independent claim 13.

### *Conclusion*

In view of the above information and remarks, Applicant respectfully requests reconsideration of the current rejections. Applicant submits that based on the foregoing, claims 1-20 are allowable over the cited prior art. Applicant further requests that a timely Notice of Allowance be issued in this case. Should any further questions arise concerning this application or in the event the above amendments do not place the application in condition for allowance, Applicant respectfully requests a telephone interview. Attorney for the Applicant may be reached at the number listed below.

Respectfully Submitted,

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